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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/487,355 06/07/95 BOLOGNESI

D 7872-027

EXAMINER

18M1/0128

ART UND TUCKE PAPER NUMBER

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1/2  
DATE MAILED: 1813

01/28/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 1/22/96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 9 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

This Office Action is in response to the election filed 11/22/96. Claim 9 is pending and rejected.

Applicant's election of ALLMOTI5 in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. After an initial search, it was decided that the requirement for election of species would be removed and all species were searched.

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The sequence of the search motif should be inserted into the claim as identifying it by the name only is not clear.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for HIV-1 gp41 peptides, does not reasonably provide enablement for any peptides from any organism or virus. The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicant has shown that particular peptides from HIV-1 gp41 can have some effect. This cannot be extended broadly to any peptide from any virus. The mechanism of infection from each of the many possible viruses that can be included in the search motif is so broad that one would have to engage in an undue amount of experimentation to find particular peptides from particular viruses that would have the desired effect. There is no guidance in the specification as to which proteins or peptides that are included in the immense number of peptides which fall within the search motifs that would inhibit viral infection. This is particularly true as each virus is different and would have a different mode of infection. Thus, the instant specification is not enabled for the scope of the invention as is now claimed.

Claim 9 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9-15 of copending Application No. 08/470896. This is a provisional double patenting

rejection since the conflicting claims have not in fact been patented.

The instant invention appears to be free of the prior art.

No claims are allowed.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 180 Fax number is: (703) 305-7939.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (703) 308-4237. The examiner can normally be reached Monday to Thursday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christine Nucker, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
JEFFREY STUCKER  
PATENT EXAMINER  
GROUP 1800